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REMARKS

In view of the above amendments and the following remarks, Applicants respectfully request review and reconsideration of the non-final Office Action mailed August 23, 2007 (hereinafter "Office Action"). In the Office Action, claims 23-44 were pending and all claims were rejected under one or more of 35 U.S.C. §112, first paragraph, 35 U.S.C. §102, and 35 U.S.C. §103. By this Amendment, claim 25 is amended. No new matter has been added.

Introductory Remarks

Prior to addressing the merits of the rejections set forth in the Office Action, Applicant wishes to note that the Office Action does not appear to be the fair and objective examination to which all applicants are entitled. The government has promulgated laws and rules that are designed to ensure fair and objective examination of patent applications and the process breaks down when one of the parties to the examination fails to abide by them. For example, *ex parte* examination of patent applications relies on rejections by an Examiner based on publications, such as patents, patent application publications, articles, books, websites, etc., that are not easily susceptible to manipulation or the frailties of human memory. The relevant patent laws and rules have been created to maintain the integrity of the patent system by attempting to eliminate bias from the *ex parte* examination process. Unfortunately, it appears that, to date, these rules have been subverted. The Examiner appears to have concluded that the claims "seem obvious" even though the Examiner has felt it necessary to resort to Official Notice to improperly fill large gaps in the prior art rejections and to contradict a declaration by a prominent, independent expert. The Examiner, apparently recognizing that her prior art rejections are lacking, has taken the unconventional step of imposing a rejection based solely on her own declaration, the Declaration of Traci L. Casler (hereinafter "Casler Declaration"). These actions appear to be legally dubious and demonstrate the sort of extreme bias that cannot be allowed in the *ex parte* examination process.

The existing laws and rules for prior art in *ex parte* prosecution recognize that the human memory is imperfect and mistakes are not only possible, but highly probable, when one attempts

to reconstruct the state of knowledge from the past without reference to contemporaneous documents and while possessing the knowledge of the present.

Applicant is particularly concerned with the rejection imposed by the Examiner based entirely on the Examiner's own declaration. The declaration is presumably some unconventional form of official notice. An unconventional form of official notice that the Examiner drafted and executed almost six and a half years after the filing date of the application and eight years after the purported prior art date of August 1999 (*see* Office Action page 3). An unconventional form of official notice that does not reference a single contemporaneous reference. The Casler Declaration is clearly inappropriate for numerous reasons, not the least of which is the fact that it references activities that occurred well after the filing date of this application. The activities referenced in the Casler Declaration include her experiences at Northern Michigan University between Summer 2002 and Fall 2004 (*see* Casler Declaration, section 5). *The Casler Declaration includes the state of the art from between one and three years after the current application's April 5, 2001 filing date.* Clearly, the Casler Declaration is a prime example of why Examiner declarations are not allowed in *ex parte* prosecution of U.S. patent applications.

Applicant's counsel is earnestly concerned that the Casler Declaration and other errors in the prosecution are symptomatic of an *ex parte* prosecution process gone awry and that Applicant has not received the fair and objective examination to which all applicants, including Applicant, are entitled. This is particularly true where the Examiner attempts to use her own unsupported declaration to override the Declaration of a prominent expert in the field, such as Philip Shelton, the C.E.O. of the Law School Admissions Counsel ("LSAC"). The Examiner's failure to properly follow and apply the patent laws and rules has been consistent throughout the process; however, the egregiousness of the Examiner's violations in the current Office Action are highly shocking to Applicant's counsel, J. Rodman Steele, Jr., who has never experienced, or heard of, such indiscretions during his 40+ year career prosecuting patents. Accordingly, Applicant respectfully requests that this application be transferred to another Examiner for continued prosecution on the merits.

Support for Claim Amendments

By this amendment, claim 25 is amended to recite that "the pre-determined score deemed to correlate with academic success at the academic institution is the final exam grade in a course covering the at least one academic discipline for regularly admitted students at the graduate school who have successfully completed one year at the graduate school." Support for this amendment can be found throughout the specification, including page 17, first full paragraph. No new matter is added by the current Amendment.

Claim Rejections Under 35 U.S.C. §112, paragraph 1

In the Office Action claims 25 and 40-41 are rejected under 35 U.S.C. §112, first paragraph, for failing to comply with the written description requirement. The Office Action asserts that the claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention.

With respect to claim 25, the Office Action asserts that the disclosure discusses a pre-determined score but sets forth no restrictions or teachings on a specific pre-determined score. Specifically the Office Action asserts that the claim limitation is narrower than that allowed by the disclosure and one of ordinary skill in the art would not know that the pre-determined score is limited to the claim language.

Applicant notes that the claims do not merely recite a "pre-determined score." Rather the claims recite "a pre-determined score deemed to correlate with academic success at the graduate school," *see* claim 23. Support for this limitation can be found throughout the specification including, page 16-17, bridging paragraph and 1st full paragraph. As amended, claim 25 recites that "the pre-determined score deemed to correlate with academic success at the academic institution is the final exam grade in a course covering the at least one academic discipline for regularly admitted students at the graduate school who have successfully completed one year at the graduate school ~~taken a course covering the at least one academic discipline~~." Support for this claim can be found throughout the specification, for example:

> Accordingly, conditionally admitted enrollees having scores which satisfy an admissions criteria, for instance those scores which place the conditionally admitted enrollee within a certain percentile, or those scores which exceed a predetermined determined value can be offered permanent admission to the academic institution. In one aspect of the invention, the admissions criteria can correspond to historical performance statistics for regularly admitted students to the academic institution. *For example, the historical performance statistics can be a median GPA or final exam grade for students who have completed one term or one year of study at the academic institution.* Notwithstanding, the invention is no limited in this regard and any admissions criteria can suffice.

Specification, page 17, first full paragraph (emphasis added).

This passage clearly demonstrates that an example of historical performance statistics for regularly admitted students can be the final exam grade. Amended claim 25, recites that the pre-determined score deemed to correlate with a likelihood of success is the final exam grade in the relevant academic institution for regularly admitted students. This is clearly supported by the cited passage of the application. No new matter is present or added.

With respect to claims 40-41, the Office Action asserts that the specification discusses a shifting range score but sets no restrictions or teachings on a specific shifting-range score. In the Response to Office Action filed April 30, 2007, Applicants cited page 13 as supporting this limitation. For the Examiner's convenience, lines 1-9, from page 13 have been reproduced below:

> In law school admissions, it is known to compute a shifting range of standardized test scores based not only on reported undergraduate GPAs and LSAT scores, but also on GPAs as reported by a law school applicant data collection services known to in the legal community as the Law School Data Assembly Service (LSDAS). Hence, a valid shifting range for use in law school admissions can include the following sequence:

LSAT Average	LSDAS GPA	Self-Reported GPA
130-135	2.80-4.33	3.00-3.49, 3.50-3.74, 3.75+
136-140	2.60-4.33	3.00-3.49, 3.50-3.74, 3.75+
141-145	2.25-2.80	2.50-2.99

The law school shifting range in claims 40 and 41 was taken directly from this passage. No new matter is added. Applicant respectfully requests that the pending rejections under 35 U.S.C. §112, first paragraph, be withdrawn.

Claim Rejections Under 35 U.S.C. §102

In the Office Action, claims 23-44 are rejected under 35 U.S.C. § 102(b) as being anticipated by "Shepard Broad Law Center's Conditional Admissions Program Prior to April 4, 2000" (hereinafter "Law Center"). Applicant respectfully submits that Law Center does not render the method of the claimed invention unpatentable.

Prior to addressing the rejection, Applicant wishes to discuss the relevant law for application of anticipation rejections. The MPEP stresses that an anticipation rejection requires that the reference teach each and every element of the claim. As set forth in MPEP 2131:

> "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).
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> ...
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> The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989)."

This means that no claim element is minor and that no claim element can be glossed over or simply ignored or else an anticipation rejection is improper.

We now turn to the claimed invention as set forth in amended claim 23, which recites:

23. (previously presented) A method for admission to a graduate school, said method comprising the steps of:

identifying a pool of standardized test takers who possess a GPA and standardized test score that are insufficient to gain regular admission to a graduate school and who did not initially apply to the graduate school, wherein the identifying step is enabled by a computer product;

offering a program for admission to the graduate school to the identified test takers, wherein the program for admission includes an abbreviated academic program;

providing instruction in at least one academic discipline to each of the test takers who accept the offer to participate in the program for admissions;

subjecting test takers in the program for admission to at least one examination during the abbreviated academic program, each test taker in the program for admissions achieving a score on the at least one examination, wherein each score is assigned using a calibrated grading process; and

admitting into the graduate school those test takers who achieve a score on said at least one examination which exceeds a pre-determined score deemed to correlate with academic success at the graduate school.

As recited in amended claim 23, the claimed method relates to a method where test takers who have not applied to a graduate school are offered the opportunity to enroll in a program for admissions. The test takers offered the opportunity to enroll in the program for admission possess a GPA and standardized test score that are insufficient to gain regular admission to the graduate school. The test takers who participate in the program for admissions receive instruction in at least one academic discipline and are subjected to at least one examination in the at least one academic discipline. Each test taker's examination is assigned a score using a calibrated grading process. Those test takers who achieve a score on the examination that exceeds a predetermined score deemed to correlate with academic success at the graduate school are enrolled in the graduate school.

Law Center does not disclose or suggest the claimed method because Law Center fails to disclose or suggest at least the following elements of amended claim 23: (i) offering participation in a program for admission to test takers who have not applied for admission, (ii) identifying a pool of standardized test takers who have not applied for admission and who possess a GPA and standardized test score that were insufficient to gain regular admission to the Law Center and offering them participation in the admissions program, (iii) grading examinations using a calibrated grading process, (iv) basing admissions on the examination score assigned using a calibrated grading process, or (v) any combination of these elements.

Although an anticipation rejection requires that each element of the claim be present in the reference, the Office Action only discusses two element of this highly detailed claim. The Office Action asserts that the "conventional curve" disclosed by Law Center is a calibrated

grading system. The Office Action also asserts that Law Center discloses an abbreviated academic program because it discloses 8-9 week courses, rather than 15-16 week semesters.

Applicant respectfully disagrees with the above characterization of the "conventional curve" described by Law Center. The Office Action reasons that a "conventional curve" is a bell curve and that a bell curve is "calibrated grading." This is simply not an accurate representation of Law Center, bell curves, or calibrated grading.

A bell curve deals with a tool for statistical analysis of a given sample population or an expected distribution. For simplicity sake, "calibrated grading" deals with how grades are assigned, whereas a bell curve deals with how a class' grades can be analyzed statistically. Ideally, a well-designed exam will result in a bell curve, but this is typically not the case. Accordingly, there is clearly a difference between a bell curve and calibrated grading.

The use of the phrase "conventional curve" in Law Center refers to how final grades, not individual exam grades, are "curved" in order to achieve a desired class average. In a conventional curve, the data used to grade the students, for example examination grades, homework grades, in-class responses, and class attendance, are combined to produce an average for each student. The averages of each student are then compared and "curved" so that the class average is within a desired, or mandated, range. For example, many law schools, such as the Law Center, "curve" grades so that the class average is within a given range, for example, 3.15–3.25 or 2.75-2.85, on a 4.0 scale.

As noted in Law Center, Law Center did not utilize calibrated grading of exams. Rather the average of exam grades and other evaluation means, including in-class participation (Socratic method), class attendance, and homework, were combined and curved to achieve a given average. Contrary to the assertions in the Office Action, Law Center simply did not use calibrated grading. Similarly, because Law Center relied on a conventional curve, which compares the class against itself, admissions decisions were not made by comparing examination scores (without considering in-class participation, class attendance, and homework) to a pre-determined score deemed to correlate with academic success at the graduate school. In this

respect, Law Center was similar to conditional admissions programs but not the claimed method of admission.

As expressly recited in Law Center, offers to participate in the admissions program were extended only to individuals who applied to the Law Center. *Individuals who did not apply for regular admission to the Law Center were not considered for participation in the admissions program.* In addition, Law Center did not solicit applications from standardized test takers who possessed a GPA and standardized test score that were insufficient to gain regular admission to the Law Center, much less offer such students participation in an admissions program.

The Office Action's assertions that Law Center expressly or inherently discloses elements that Law Center affirmatively states were not present is confounding. Applicant respectfully asserts that Law Center does not disclose or suggest the claimed methods.

Applicant also points out the Office Action asserts that Law Center anticipates all pending claims

, including:

24. Which expressly state that no credit is awarded for the classes. Law School expressly states that credit was awarded.

26-27. Which expressly claims an abbreviated academic program lasting 7 weeks or less. Law Center expressly states that it used conventional 8 to 9 week summer session. Contrary to the assertions in the Office Action, these limits are not merely "non-functional descriptive material." Applicant has discovered that the future performance of individuals with sub-par GPAs and standardized test scores can be predicted by comparing their performance on examinations given following a 5-7 week abbreviated academic program (4-6 weeks of instruction) against the results of regularly admitted students on examinations following a 14 week semester. This is an unexpected result that is neither disclosed nor suggested by any of the cited references.

For at least the above reasons, Applicant respectfully requests that the rejection based on Law Center be withdrawn.

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Claim Rejections Under 35 U.S.C. §103

In the Office Action, claims 23-44 are rejected under 35 U.S.C. §103 as being unpatentable over the Declaration of Traci L. Casler (hereinafter "Casler Declaration"). The Office Action appears to assert that the priority date of the Casler Declaration is August 1999, *see* Office Action, paragraph 6. Applicant asserts that the Casler Declaration is facially insufficient to serve as a prior art reference because the Casler Declaration (1) does not qualify as prior art under 35 U.S.C. §102, and (2) includes content beyond the scope of that allowed for Examiner declarations, *i.e.* official notice. Furthermore, the Casler Declaration is extremely probative evidence of bias, particularly when combined with the Law Center anticipation rejection, which asserts that Law Center discloses claim elements that Law Center affirmatively indicates were not present and the Examiner's complete disregard for the expert declaration submitted by Philip D. Shelton, C.E.O of the Law School Admission Counsel.

The government has promulgated laws and rules that are designed to ensure a fair and objective examination and the process breaks down when one of the parties to the examination fails to abide by them. For example, *ex parte* examination of patent applications relies on rejections based on publications, such as patents, patent application publications, articles, books, web sites, etc., that are not easily susceptible to manipulation or the frailties of the human memory. These laws and rules have been created to maintain the integrity of the patent system by attempting to eliminate bias from this aspect of the *ex parte* examination process.

The Casler Declaration is not prior art under any subsection of 35 U.S.C. §102. The Office Action asserts a prior art date of August 1999. However, the substance of the Casler Declaration is based on Examiner Casler's employment at Northern Michigan University (NMU), which lasted from July 2000 through April 2004, *see* Casler Declaration, sections 2, 4 and 5. Section 5 is based entirely on an actual student who interacted with Examiner Casler between Summer 2002 and Spring 2004. This entire period is between one and three years after Applicant's April 5, 2001 filing date. Accordingly, the Casler Declaration is not valid prior art.

Furthermore, the Casler Declaration includes content beyond the scope of that allowed for Examiner declarations. Declarations by Examiners should be limited to unassailable facts,

not attempts to controvert sworn statements made by eminent scholars in the field, such as Philip Shelton, C.E.O. of the Law School Admission Counsel. Furthermore, there are serious questions as to the veracity of Ms. Cassler's declaration. In particular, the current application was filed April 5, 2001. As noted by the Examiner, the experiences she is attempting to recollect occurred during her experience with Northern Michigan University from July 2000 through April 2004. Thus, for Ms. Cassler's declaration to be accurate she must distill the first 9 months of her experience from the 36 months after the priority date of the claimed invention. Subsection 5, which spans the period from Summer 2002 to Spring 2004, clearly demonstrates that Examiner Casler has failed to rely exclusively on material that qualifies as prior art, such as the published information readily available from www.webarchive.org relevant to the admission policies used at the two Universities where she was employed. The fact that this route was not utilized is nothing short of suspicious and reinforces the belief of Applicant's counsel that Applicant is not receiving objective examination of his invention.

The only area where an examiner declaration may be appropriate is the taking of official notice. *In re Ahlert*, 424 F. 2d 1088 (CCPA 1970), addresses when official notice is appropriate and how official notice may be used. The *In re Ahlert* Court noted:

> [Examiner's] may take notice of facts beyond the record which, while not generally notorious, are *capable of such instant and unquestionable demonstration as to defy dispute*. In re Knapp Monarch Co., 296 F.2d 230 (1961). **This rule is not, however, as broad as it first might appear, and this court will always construe it narrowly and will regard facts found in such manner with an eye toward narrowing the scope of any conclusions to be drawn therefrom.**

Id. at 1091 (*emphasis added*). *See also* MPEP 2144.03.A.

Clearly, the facts at issue here are not "*capable of such instant and unquestionable demonstration as to defy dispute*," because the Examiner is using her declaration as a means of rebutting the affidavit submitted by Mr. Philip Shelton, C.E.O. of the Law School Admission Counsel. A fact simply cannot be "*capable of such instant and unquestionable demonstration as to defy dispute*," where a prominent expert, such as Mr. Shelton, makes a statement to the

contrary and the best rebuttal the Examiner can identify is her own declaration, which is neither prior art, nor appropriate subject matter for official notice.

Also pertinent to the current situation, the *In re Ahlert* court stated:

> These aspects of judicial notice are primarily procedural, however, designed with the purpose in mind of fully utilizing the independent and specialized technical expertise of the Patent Office examiners while balancing the applicant's rights to fair notice and an opportunity to be heard. Equally important is the question of what role the facts so found may play in the evidentiary scheme upon which a rejection of claims is based. Typically, it is found necessary to take notice of facts which may be used to supplement or clarify the teaching of a reference disclosure, perhaps to justify or explain a particular inference to be drawn from the reference teaching. *The facts so noticed serve to "fill in the gaps" which might exist in the evidentiary showing made by the examiner to support a particular ground for rejection.* ***We know of no case in which facts judicially noticed comprised the principal evidence upon which a rejection was based or were of such importance as to constitute a new ground of rejection when combined with the other evidence previously used.***

Id. at 1092 (*emphasis added*). *See also* MPEP 2144.A. and E.

Thus, in addition to the factual inconsistencies of the Casler Declaration, which call the credibility of the rejection (and the entire protracted examination process to date) into question, the Examiner's rejection based solely on her own affidavit appears to be completely at odds with the intent of official notice. Accordingly, Applicant respectfully requests that the rejection based on the Casler Declaration be withdrawn.

In the Office Action, claims 23-44 are rejected under 35 U.S.C. §103 as being unpatentable over Arenson, "Opponents of Change in CUNY Admissions Policy Helped Pass a Compromise Plan," November 24, 1999 (hereinafter "CUNY"), in view of www.gradcollege.swt.edu, February 29, 2000 (hereinafter "Grad College").

Prior to addressing the rejection, Applicant would like to review some law relevant to this, and all, rejections. The MPEP stresses the importance of considering the invention ***as a whole***. In section 2141.02, the MPEP instructs:

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> In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983); *Schenck v. Nortron Corp.*, 713 F.2d 782, 218 USPQ 698 (Fed. Cir. 1983).

The MPEP clarifies that an invention is not considered "as a whole" when the Examiner falls prey to the temptation to distill the invention down to a "gist" or a "thrust." Section 2141.02. II. of the MPEP states:

> Distilling an invention down to the "gist" or "thrust" of an invention disregards the requirement of analyzing the subject matter "as a whole." *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984) (restricting consideration of the claims to a 10% per second rate of stretching of unsintered PTFE and disregarding other limitations resulted in treating claims as though they read differently than allowed); *Bausch & Lomb v. Barnes-Hind/Hydrocurve, Inc.*, 796 F.2d 443, 447-49, 230 USPQ 416, 419-20 (Fed. Cir. 1986), *cert. denied*, 484 U.S. 823 (1987) (District court focused on the "concept of forming ridgeless depressions having smooth rounded edges using a laser beam to vaporize the material," but "disregarded express limitations that the product be an ophthalmic lens formed of a transparent cross-linked polymer and that the laser marks be surrounded by a smooth surface of unsublimated polymer."). See also *Jones v. Hardy*, 727 F.2d 1524, 1530, 220 USPQ 1021, 1026 (Fed. Cir. 1984) ("treating the advantage as the invention disregards statutory requirement that the invention be viewed 'as a whole'"); *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1 USPQ2d 1593 (Fed. Cir.), *cert. denied*, 481 U.S. 1052 (1987) (district court improperly distilled claims down to a one word solution to a problem).

As is noted in the discussion to follow, substantial portions of the rejection based on CUNY and Grad College attempt to distill the invention down to a "gist," rather than considering the claims as a whole. For example, the rejection summarily dismisses certain claim elements as well-known, ignores other claim elements, and breaks the claims into unrecognizably small parts rather than considering the interrelated phrases that make up the claimed method as a whole.

A *prima facie* case of obviousness requires (1) a motivation or suggestion to combine the teachings of the references, (2) a reasonable expectation of success, and (3) that the prior art

references or knowledge of one skilled in the art must teach or suggest all the claim limitations. *See* MPEP §2143. An obviousness rejection cannot be sustained if any of these elements is not established or the applicant can rebut any of the elements.

As presented in the following discussion, the combination of CUNY and Grad College does not disclose or suggest: (i) offering a program for admission to test takers who have not applied for admission, (ii) offering a program for admission to test takers who have not applied for admission and who possess GPAs and standardized test scores that are insufficient to gain regular admission to the graduate school, (iii) calibrated grading of examinations, (iv) offering a program for admission consisting of an abbreviated academic program that the test takers may participate in without a personal recommendation from a graduate advisor, (v) offering a program for admissions having a duration of five to seven weeks, or (vi) any combination of these elements. Accordingly, Applicant believes that all claims are drawn to allowable subject matter.

Before addressing the assertions in the Office Action, it is important to note that the CUNY article deals with a legislated compromise to address a difficult transitional situation: increased standards for admission to CUNY senior colleges. Because of this individuals of ordinary skill in the art would understand that the CUNY approach to the transition is not being advocated as an admissions program and would not combine CUNY with traditional admissions approaches, such as Grad College. Thus, CUNY teaches away from the combination relied upon in the rejection.

As is clear from the CUNY article, without the compromise the increased admission standards would not have been ratified because the new admission standards effectively revoked the acceptances of 248 students to CUNY senior colleges, *see* CUNY, paragraph 7. The compromise described in the article was an emergency, one-time approach for dealing with the politically volatile situation created by the increased admission standards, *see* CUNY, paragraphs 1 & 4-6. There is nothing in the article to indicate that the approach provided a workable or desirable approach to either side. The approach was merely a concession to satiate those who vigorously opposed the impact the increased admission requirements had on the 248 students

who were previously admitted to CUNY senior colleges, *see* CUNY, paragraphs 4-6. Even so, the article indicates that the legislated compromise was unacceptable to the educators involved, *see* CUNY, paragraphs 4-6 and 11-end. A person of skill in the art would understand that the compromise described in the CUNY article was an unacceptable compromise to deal with a very specific temporary situation, not a new admissions program. Accordingly, even if CUNY did disclose what the Office Action asserts, there would be no motivation to combine CUNY with any other admissions program, including Grad College.

Arenson indicates that as part of the compromise, CUNY's undergraduate program offered some CUNY applicants an opportunity to take remedial classes in order to improve their scores on an admissions test. Arenson does not disclose or suggest seeking out non-applicants with numerical credentials that are insufficient to gain regular admission to a graduate school. In fact, the only reason these 248 individuals were being given this chance was that their acceptances in CUNY senior colleges were revoked when the admission requirements were increased.

In addition, CUNY deals with undergraduate education, not graduate education. Some people of ordinary skill in the art believe that students are entitled to an undergraduate education, even if remedial classes are necessary to prepare the individual for undergraduate classes. This is generally justified as a necessary correction for the public school system's failure to address the needs of these individuals who are unprepared for an undergraduate education. However, this belief and justification does not extend to graduate education. *Administrators of graduate schools require that test takers possess certain skills and knowledge prior to admitting them to the graduate school.*

In contrast to the compromise disclosed in the CUNY article, Applicant Harbaugh's claimed method of admissions is capable of identifying those test takers who possess insufficient numerical credentials (GPA and standardized test scores), but possess the necessary knowledge and skills to succeed in graduate school. This is a significant distinction that is neither disclosed nor suggested by CUNY or any other cited references.

Additionally, there is no motivation, suggestion or teaching in the cited references or the knowledge of one having ordinary skill in the art to combine references to reach the claimed invention. In particular, because one of ordinary skill in the art would discard the CUNY transitional approach as an ***unacceptable political solution*** that is not supported by educational theory.

Grad College provides for conditional admission decisions at Southwest Texas State University for ***applicants*** who do not meet the GPA and Graduate Record Exam (GRE) requirements. The Grad College conditional admissions program is available only if the graduate advisor in the degree program which the applicant seeks to enter identifies specific evidence that the applicant can successfully pursue graduate study, *see* Grad College, p. 7. The context of the cited materials demonstrates that Grad College only deals with individuals who file formal applications to Southwest Texas State University that are denied.

Conditional admissions decisions made using the Grad College reference are limited to individual test takers and are only available where the test taker (a) files an application, (b) seeks out the graduate advisor of the desired degree program, and (c) convinces the relevant graduate advisor to recommend conditional admission based on some evidence the test taker can succeed in the graduate program. Grad College does not provide any motivation or suggestion to solicit applications from non-applicants with numerical credentials that do not meet the admissions requirements. Grad College does not provide any motivation or suggestion to offer a program for admission where test takers possessing inadequate numerical credentials are automatically enrolled if they achieve a pre-determined score on an examination or examinations administered during the program for admission. Finally, Grad College clearly does not provide any motivation, suggestion or teaching for a combination of these two claimed elements.

As noted above, the knowledge of one of ordinary skill in the art leads graduate schools to request the names of test takers whose GPA and standardized test score meet or exceed the admissions requirements of the graduate school. These individuals are invited to apply for admission to the graduate school. Thus, the knowledge in the art provides no motivation or suggestion to (1) identify a group of test takers who possess numerical credentials that do not

meet a graduate school's admission requirements, or (2) to invite this group of test takers to participate in the claimed program for admissions, where each test taker that accepts the invitation is allowed the opportunity to be admitted to the graduate school without the need to file a conventional application for admission or a recommendation from a graduate advisor.

In the Office Action, the Examiner takes official notice that "it is old and well-known in the art of admissions to purchase or gain access to a list of students in a particular category in order to target enrollment," Office Action, page 4. The first problem with this attempt at official notice is that the Examiner is attempting to use official notice to disclose an entire complex, claim limitation. *In re Ahlert*, 424 F. 2d 1088, 1091 (CCPA 1970), states that, "Typically, it is found necessary to take notice of facts which may be used to supplement or clarify the teaching of a reference disclosure, perhaps to justify or explain a particular inference to be drawn from the reference teaching." In the present case, the Examiner is attempting to use official notice to disclose the limitation of "identifying a pool of standardized test takers who possess a GPA and standardized test score that are insufficient to gain regular admission to a graduate school and who did not initially apply to the graduate school." It should be abundantly clear that this is an attempt to take Official Notice *as the teaching*, not to clarify the teaching.

Another problem with this example of official notice is that, even if we assume that this statement is accurate, the relevant claim language deals with identifying a pool of test takers "who possess a GPA and standardized test score that are insufficient to gain regular admission to a graduate school." In his declaration submitted August 24, 2005, Mr. Philip D. Shelton, CEO of the Law School Admission Counsel stated:

> Nova Southeastern identifies AAMPLE® candidates by using the CRS databased to search for persons with low LSAT scores who are unlikely to get admitted to any law school. I am unaware of any other law school or other academic institution that conducts a search for "under-qualified" students, particularly students who did not initially apply to the academic institution.

Shelton Declaration, section 7.

Mr. Shelton goes on to state that, "The claimed methods are more effective at identifying students with a lower LSAT score who perform at the high end of the bell curve [for each LSAT

score] more effectively than any other admissions method of which I am aware." ***Applicant notes that searching for individuals with GPAs and standardized test scores that are insufficient to gain regular admission to the graduate school simply does not make any sense absent that ability to successfully identify which students with GPAs and standardized test scores that are insufficient to gain regular admission to the graduate school will perform at the level of those who do possess sufficient GPAs and standardized test scores.*** The traditional approach for a graduate school to expand its applicant pool is to lower its standards and solicit individuals who meet the modified standards.

Because others have been unable to identify a better method of identifying individuals who will succeed in a graduate school despite a low GPA and test score, other academic institutions have not sought out such individuals. The claimed method as a whole has unexpectedly solved this problem.

As noted in the Reply to Office Action filed April 30, 3007, Office Notice is only appropriate where the subject matter of the notice is "capable of such instant and unquestionable demonstration as to defy dispute." *In re Ahlert*, 424 F. 2d 1088, 1091 (CCPA 1970). In the Office Action, the Examiner completely ignores very specific statements made by Mr. Shelton, a recognized expert in the field of graduate school admissions, based on her official notice regarding some vague concept of searching for "students in a particular category in order to target enrollment." This is clearly outside the scope of when official notice is appropriate, *i.e.* where the subject matter of the official notice is "capable of such instant and unquestionable demonstration as to defy dispute" Furthermore, the ability to seek-out students in a "particular category" does not make it obvious to create an entire admissions program based on identifying non-applicant, test takers who do not meet the graduate school's admissions requirements. Without the benefits of the claimed method, such an approach would defeat the entire purpose of having admission standards.

Applicant respectfully traverses any assertion that graduate schools conduct searches for test takers with a standardized test score and an undergraduate GPA that are insufficient to gain regular admission to graduate schools. Applicant's position is supported by the sworn statements

of Philip D. Shelton, CEO of the Law School Admissions Counsel (LSAC). Over the past thirty-two years, Affiant Philip D. Shelton has been continuously and intimately involved in graduate school admissions as a law school dean, as a senior member of LSAC, and now as CEO of LSAC. In his positions as law school dean and CEO of the LSAC, Mr. Shelton has been in constant contact with law school deans and administrators who are (a) searching for the names of potential admissions candidates and (b) experimenting with new ways to make admissions decisions. In Mr. Shelton's extensive experience, he unequivocally states that Applicant Harbaugh is the only graduate school administrator he has known or heard of that has ever requested names of students with GPAs and standardized test scores clearly outside the range of those acceptable to the requesting graduate school, *see* Affidavit of Philip D. Shelton, paragraph 7.

Applicant respectfully asserts that Mr. Shelton can be considered nothing less than a prominent expert in the relevant art. The Office Action is trying to take official notice of something that Mr. Shelton expressly stated was unknown to him. Clearly, these facts are not "capable of instant and unquestionable demonstration as being well-known" and do not meet the requirements set forth for official notice under MPEP 2144.03. Accordingly, the MPEP requires that the Examiner provide documentary evidence in the next Office action if the rejection is to be maintained on this ground, *see* MPEP 21440.3.C.

The MPEP requires that where official notice is traversed, "the examiner must provide documentary evidence in the next Office action if the rejection is to be maintained," MPEP 21440.3.C. Applicant requested such documentary evidence in page 15 of the Response to Office Action filed April 30, 2007; however, no such evidence has been proffered by the Examiner.

Clearly, the cited references do not disclose or suggest each element of the claimed invention. Clearly, neither the cited references nor the knowledge of one skilled in the art provide any motivation or suggestion to combine Grad College, or any other cited reference, with other references to create the claimed method of admission. Accordingly, Applicant believes that all claims are drawn to allowable subject matter.

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Secondary Considerations

With respect to the pending claims, and claim 44 in particular, Applicant respectfully requests that the Examiner consider secondary considerations, such as the failure of others and long-felt but unresolved needs, as indicia of nonobviousness, *see* MPEP §716.01(a). Philip D. Shelton, President of the LSAC, the group that administers the LSAT, states that the LSAT is the best standardized admission test in the admission testing industry. *See* Affidavit of Philip D. Shelton. The score a test taker achieves on the LSAT, while representing a bell curve centered on that value, is indicative of the most likely level of performance in law school. Thus, like all bell curves, a significant percentage of test takers with a given score will perform better than the mode, *i.e.* the performance level of the test taker with a given score having the average performance level in law school.

Mr. Shelton states that *even after extensive research*, the LSAC has been unable to identify a single variable or combination of variables that will identify test takers who will significantly outperform test takers with much higher scores. *See* Affidavit of Philip D. Shelton, paragraph 4. Mr. Shelton goes on to state:

> The claimed methods [of the present invention] are more effective at identifying students with a lower LSAT score who perform at the high end of the bell curve more effectively than any other admissions method of which I am aware. In short, the AAMPLE® program incorporating the claimed methods presents a method that has proven successful for identifying "diamonds in the rough" who will perform well at law school despite a relatively low LSAT score.

See Affidavit of Philip D. Shelton, paragraph 6.

As noted above, the LSAT is the best standardized admissions test in the industry. Thus, if the LSAT cannot identify high-performing, low-scoring test takers, neither can the MCAT, DAT, VCAT, PCAT, AHPAT, GRE, or the GMAT. In fact, the need for the method of the present claims would be even greater for these other admissions tests.

In response to the above secondary considerations, the Office Action asserted that Applicant has not shown that the claimed invention has successfully identified students who will perform better than higher test scorers in an actual law program, *see* Office Action, paragraph 30.

This challenge to the secondary consideration was not present in the Withdrawn Office Action. Accordingly, Applicant believes that the arguments submitted in the Reply dated October 24, 2006 overcame the challenge. In either case, Applicant reasserts these arguments found on pages 14 through 16 of the Reply filed October 24, 2006.

Even if the cited references did meet the elements of a prima facie case of obviousness, which they do not, Applicant believes that these secondary considerations would overcome the prima facie case of obviousness. Accordingly, Applicant respectfully requests allowance of all pending claims.

Conclusion

For at least the reasons set forth above, the independent claims are believed to be allowable. In addition, the dependent claims are believed to be allowable due to their dependence on an allowable base claim and for further features recited therein. The application is believed to be in condition for immediate allowance. If any issues remain outstanding, Applicant invites the Examiner to call the undersigned if it is believed that a telephone interview would expedite the prosecution of the application to an allowance.

Respectfully submitted,

AKERMAN SENTERFITT

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Docket No. 6994-1